

### **REMARKS**

The Office Action mailed November 17, 2004 has been carefully reviewed and, in view of the above amendments and following remarks, reconsideration and allowance of the application are respectfully requested.

#### **I. Discussion of Drawing Objections**

The Office Action includes an objection to the drawings because Figures 6, 7, 8, and 9 are mentioned in the specification, but not included in the drawings. With reference to the above amendments to the specification, various portions of the Detailed Description are amended to include references to Figures 6A-6B, 7A-7D, 8A-8B, or 9A-9B. The Applicants submit that these amendments to the specification overcome the objection and request, therefore, that this objection be withdrawn.

The Office Action also included an objection to the drawings for not including reference numerals 700, 711-714, 741-744, and 760. With regard to reference numeral 700, the Applicants refer the Examiner to Figures 3, 4, and 5 in which reference numeral 700 is shown. With regard to reference numerals 711-714, 741-744, and 760, the Applicants refer to a Preliminary Amendment filed February 3, 2003 in which a proposed drawing change was submitted for approval by the Examiner. The proposed drawing change includes the addition of each of reference numerals 711-714, 741-744, and 760. Accordingly, the Applicants respectfully request that the Examiner accept the proposed drawing change and withdraw this objection.

#### **II. Summary of Claims**

Claims 1-7, 9-17, 19-23, and 25-26 are currently pending in the application, with claims 1, 10, 19, and 26 being independent claims. Claims 8, 18, and 24 are cancelled; claim 25 is added; and claims 1, 4-5, 7, 9-11, 13-15, 17, and 19-22 are amended, in accordance with the above amendments.

The following claim rejections were submitted by the Examiner in the outstanding Office Action:

- Claims 1-5, 9-15, and 19-23 are rejected under 35 U.S.C. §102(b) as being anticipated by European Patent Application Publication Number 0 510 943 (hereafter referred to as the European Patent);

- Claims 6-8, 16-18, and 24-25 are rejected under 35 U.S.C. §103 as being unpatentable over a combination of the European Patent and U.S. Patent Number 5,983,529 to Serna.

### **III. The Claims Patentably Distinguish Over The Applied Prior Art**

#### ***Discussion of Independent Claim 1***

Independent claim 1 recites an article of footwear for receiving a foot of a wearer. The footwear includes an upper and a sole structure attached to the upper. The sole structure includes a midsole and an outsole. The midsole has a compressible first support element located above a portion of the outsole and in a back-lateral corner of the sole structure. A lower surface of the first support element has a downward bevel in a lateral-to-medial and back-to-front direction. A lower surface of the outsole has a corresponding downward bevel in the lateral-to-medial and back-to-front direction, with the downward bevel of the first support element being positioned above the downward bevel of the outsole.

Independent claim 1 is rejected as being anticipated by the European Patent, which discloses an article of footwear with an energy return system. The footwear has a sole structure with a midsole, and the energy return system is embedded within the midsole (see Figure 1 of the European Patent). The energy return system includes a top plate, a bottom plate, an intermediate plate, and a plurality of base members extending between the plates. The energy return system is spaced inward from sides of the sole structure and from a rear area of the sole structure. In addition, a lower surface of the sole structure appears to have a textured structure, but has an otherwise generally planar configuration.

In contrast with the European Patent, independent claim 1 recites that each of the first support element and the outsole have downward bevels, and the downward bevel of the first support element is positioned above the downward bevel of the outsole. This combination of features is neither taught nor suggested by the European Patent.

Based upon the above discussion, the Applicants respectfully submit that independent claim 1 is allowable over the European Patent. In addition, claims 2-5 and 9 should be allowable for at least the same reasons, and claims 6-7 should be allowable since Serna does not remedy the deficiencies of the European Patent.

*Discussion of Independent Claims 10 and 19*

Independent claim 10 recites an article of footwear for receiving a foot of a wearer. The footwear includes an upper and a sole structure attached to the upper. The sole structure includes a midsole and an outsole. The midsole defines a void extending through the sole structure and from a medial side to a lateral side of the sole structure. The midsole also includes a compressible first support element with a columnar and vertically-projecting structure. The first support element is located within the void and in a back-lateral corner of the sole structure, and the first support element extends between upper and lower portions of the void. A lower surface of the first support element has a downward bevel in a lateral-to-medial and back-to-front direction. Similarly, a lower surface of the outsole has a corresponding downward bevel in the lateral-to-medial and back-to-front direction. The downward bevel of the first support element is positioned above the downward bevel of the outsole. Independent claim 19 recites a similar configuration wherein four support elements are present.

Independent claims 10 and 19 are also rejected as being anticipated by the European Patent and should be allowable for the same reasons. That is, independent claims 10 and 19 also recite that each of the first support element and the outsole have downward bevels, and the downward bevel of the first support element is positioned above the downward bevel of the outsole.

Additionally, independent claims 10 and 19 recite that (1) the midsole defines a void extending through the sole structure and from a medial side to a lateral side of the sole structure, (2) the first support element is located within the void, and (3) the first support element extends between upper and lower portions of the void. This combination of features is neither taught nor suggested by the European Patent.

Based upon the above discussion, the Applicants respectfully submit that independent claims 10 and 19 are allowable over the European Patent. In addition, claims 11-15 and 20-23 should be allowable for at least the same reasons, and claims 16-17 and 25 should be allowable since Serna does not remedy the deficiencies of the European Patent.

*Discussion of Independent Claim 26*

Independent claim 26 recites an article of footwear having an upper and a sole structure secured to the upper. The sole structure includes a pair of plates, a first support element, a

second support element, a third support element, a fourth support element, and an outsole. The pair of plates are spaced apart to define a void extending through the sole structure, and the void extends from a medial side of the sole structure to a lateral side of the sole structure. The first support element is located within the void and extends between the pair of plates. The first support element is positioned in a back-lateral corner of the sole structure, and a lower surface of the first support element has a first downward bevel in a lateral-to-medial and back-to-front direction. The outsole forms a ground-contacting surface of the article of footwear. In addition, the outsole extends under the first support element and has a second downward bevel in the lateral-to-medial and back-to-front direction. The second downward bevel is positioned below the first downward bevel.

The combination of features recited by independent claim 26 is not taught or suggested by the European Patent, Serna, or the combination of the European Patent and Serna.

#### IV. Conclusion

In view of the foregoing, the Applicants respectfully submit that all claims are in a condition for allowance. The Applicants respectfully request, therefore, that the rejections be withdrawn and that this application now be allowed.

This Amendment is being timely filed by facsimile transmission on February 14, 2005. Should additional fees or an extension of time be deemed necessary for consideration of this Amendment, such fees or extension are hereby requested and the Commissioner is authorized to charge deposit account number 19-0733 for the payment of the requisite fee. If anything further is desirable to place the application in even better form for allowance, the Examiner is respectfully requested to telephone the undersigned representative at (503) 425-6800.

Respectfully submitted,

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